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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/579,407

05/25/2000

David L. Bates

TMC-101US

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07/15/2005

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.

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SUITE 1030

MILWAUKEE, WI 53202

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,407

Applicant(s)

BATES ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 3/14/05, the following has occurred: not claims have been added, canceled, nor amended. Now, claims 1-24 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-9, 11, 13-18, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462.
4. As per claim 1, Mitcham teaches a method of generating an insurance quote for an individual, comprising the steps of: obtaining data from an applicant for insurance (see column 5, lines 12-28); automatically underwriting an insurance risk for an item using the data obtained from the applicant (see column 6, lines 4-10); and generating and providing an insurance quote to the applicant wherein the insurance quote is for the provision of insurance to cover the item (see column 6, lines 10-25).
5. Mitcham does not explicitly teach determining the acceptability of a loan, obtaining data from a lender's database and using the data to underwrite a corresponding insurance risk, and advising the applicant of the acceptability of the loan contemporaneously with providing the insurance quote. Jones teaches a method for determining the approval status of a potential borrower (see column 3, lines 23-31); and further utilizing the method to provide data regarding the potential borrower to an insurance provider to permit follow-up with the potential borrower

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(see column 3, lines 23-31 and column 7, lines 31-45). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting insurance providers and lenders for the purpose of further decreasing the amount of time needed to purchase and insure a vehicle by a potential customer (see column 4, lines 17-24).

6. As per claim 3, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the insurance quote is provided by an insurance provider (see column 6, lines 1-4).

7. As per claim 4, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the step of underwriting the insurance risk includes the additional steps of: providing a plurality of insurance companies for underwriting the insurance risk (see column 5, lines 58-65); and determining a set of terms for each of the plurality of insurance companies for which each of the plurality of insurance companies will accept the insurance risk (see column 5, line 66 – column 6, line 4).

8. As per claim 5, Mitcham in view of Jones teach the method of claim 4 as described above. Mitcham further teaches the additional step of selecting one of the sets of terms and providing the insurance quote in response thereto (see column 6, lines 15-19).

9. As per claim 6, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant (see column 6, lines 39-45).

10. As per claim 7, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the additional steps: storing the data after providing the insurance quote (see column 8, lines 38-41); and providing an additional insurance quote in response to a request by the applicant (see column 8, lines 55-59).

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11. As per claim 8, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches the step of requesting permission from the applicant prior to obtaining data from additional sources (see column 43-58).

12. As per claim 9, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham further teaches a second portion of the data is obtained from a third party (see column 7, lines 55-61).

13. Claims 11, 13-18, 20, and 22-23 contain substantially similar limitations to claims 1 and 3-9 and, as such, are rejected for similar reasons as given above.

14. Claims 2, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462 and further in view of Danilunas et al., U.S. Patent no. 6,263,320.

15. As per claim 2, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham does not explicitly teach providing the insurance quote by the lender. Danilunas teaches a method for utilizing a financial product for the financing of an automobile purchase and further providing automobile insurance to the potential purchaser of the automobile (see column 5, lines 5-24). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting insurance providers and lenders for the purpose of enabling the selling of such insurance services at a discounted rate (see column 5, lines 5-7 of Danilunas).

16. Claims 12 and 21 contain substantially similar additional limitations to claim 2 and, as such, are rejected for similar reasons as given above.

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17. Claims 10, 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462 and further in view of Dugas, **Not the total solution Bankruptcy stays on credit reports.**

18. As per claim 10, Mitcham in view of Jones teach the method of claim 1 as described above. Mitcham does not explicitly teach that the third party is a credit bureau. Dugas discloses third party reporting of information for an application for insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time of the invention to include the step of obtaining data in the system of Mitcham from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to perform such a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

19. Claims 19 and 24 contain substantially similar additional limitations to claim 10 and, as such, are rejected for similar reasons as given above.

Response to Arguments

20. In the remarks filed 9/23/04, Applicant argues in substance that (1), Mitcham fails to teach generating an insurance quote from data obtained from a lenders database; (2) Jones fails to teach generating an insurance quote from the data provided to the insurance companies.

21. In response to Applicant's arguments (1) and (2), it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this, case, Applicant is arguing that each reference fails to teach certain features when the Examiner has not specifically relied upon the respective reference to teach the particular feature. For Example,

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Applicant argues that Jones requires an insurance company to approach the applicant and for the applicant to fill out an application requesting insurance. However, the Examiner has relied upon the teachings of Mitcham, rather than Jones, to disclose the generation of an insurance quote.

22. It is further noted that the test for obviousness is not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Given that Mitcham discloses providing an insurance quote without requiring any direct interaction with an insurance company (see column 4, lines 9-12) and that Jones discloses providing insurance companies with borrower information for the purpose of immediate follow up (see column 7, lines 43-45), it is respectfully maintained that the combination of Mitcham and Jones, along with the knowledge generally available to one of ordinary skill in the art, teach the features of automatically underwriting an insurance risk based on borrower data.

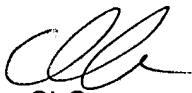
Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

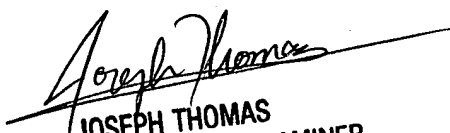
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CLG
7/8/05



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